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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): WATANABE, et al.

Serial No.: 09/762,823

Filed: April 23, 2001

For: ADHESIVE FOR BONDING CIRCUIT MEMBERS, CIRCUIT BOARD  
AND PROCESS FOR ITS PRODUCTION

Group: 1714

Examiner: Cain

**RESPONSE**

Assistant Commissioner for Patents  
Washington, D.C. 20231

April 21, 2003

Sir:

The following is in response to the Office Action of January 21, 2003 in the  
above-identified application.

**REMARKS**

Claims 1 - 22 and 26 - 32 are pending in the above-identified application.

Claims 22 and 26 - 31 are withdrawn from consideration.

In the Office Action of January 21, 2003, Claims 1 - 21 and 32 were rejected.

No claim was allowed. Reexamination and reconsideration are respectfully  
requested in view of the following remarks.

**Rejection of Claims 1 and 13 under 35 U.S.C. §112, second paragraph**

Claims 1 and 13 were rejected under 35 U.S.C. §112, second paragraph, as  
being indefinite. The Examiner noted that the claims recite 10 to 200 parts by weight

of inorganic filler. The Examiner alleged that it was not understood how the inorganic filler could have an upper limit of 200 since the adhesive resin composition is considered as including the resin and the filler.

This rejection is respectfully traversed. In particular, the Examiner is in error in alleging that the adhesive resin composition is considered as including the resin and the filler. Claim 1 and 13 both recite an “adhesive layer”. The “adhesive layer” is defined as containing an “adhesive resin composition” and an “inorganic filler.” Clearly, the “adhesive resin composition” and the “inorganic filler” are defined in the claim as separate materials. The category of “adhesive resin composition” does not include the category of “inorganic filler”. Thus, it is possible to discuss the relative amounts of the adhesive resin composition and the inorganic filler and it is possible for there to be instances in which the weight of the filler exceeds the weight of the adhesive resin composition. Accordingly, it is respectfully submitted that the limitation that the inorganic filler is contained in an amount of from 10 to 200 parts by weight based on 100 parts of the adhesive resin composition would be readily understood by persons skilled in the art and is not indefinite.

Withdrawal of the rejection of Claims 1 and 13 under 35 U.S.C. §112, second paragraph, is respectfully requested.

**Rejection of Claims 1 - 2 and 32 under 35 U.S.C. §102(e) over Watanabe**

Claims 1 - 2 and 32 were rejected under 35 U.S.C. §102(e) as anticipated by Watanabe (U.S. Patent No. 6,328,844). The Examiner alleges that Watanabe discloses adhesive compositions comprising both insulative and conductive fillers

and that the adhesive is taught as having a modulus of elasticity of between 100 and 2,000 MPa at 40°C. The Examiner further alleges that the inorganic fillers are taught to be present in amounts at least greatly overlapping those claimed.

The Examiner further stated that the changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of the application because it was not filed on or after November 29, 2000 or voluntarily published under 35 USC 122(b). The Examiner stated that the application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA.

This rejection is respectfully traversed on the grounds that U.S. Patent No. 6,328,844 to Watanabe cannot be applied as prior art against the present application. Please note the following discussion:

**Determination of effective filing date of the present application**

The present application is a national application based on a prior filed international application under 35 U.S.C. 371 which designated at least one country other than the US. Under 35 U.S.C. 365 (a), the national application is entitled to the filing date of the prior international application. In the present instance, the filing date of the prior international application, PCT/JP98/03609 is August 13, 1998. (See, for example, Form PCT/DO/EO/903 of record in the application.) Amendments made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) have no relevance to the determination of the effective filing date of an application under 35 U.S.C. 365 (a).

**Determination of date under 35 U.S.C. 102(e) for the Watanabe patent**

U.S. Patent No. 6,328,844 to Watanabe was filed in the US on August 24, 1999, based on international application PCT/JP97/02455 filed on July 15, 1997. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to this reference because it was not filed on or after November 29, 2000 or voluntarily published under 35 USC 122(b). Thus, the reference is to be applied as of its US filing date of August 24, 1999. (See MPEP 706.02(f)(1)(I)(3)(a)).

Since the filing date of 8/24/99 of Watanabe is after the effective filing date of 8/13/98 of the present application, Watanabe U.S. Patent No. 6,328,844 cannot be applied as a reference under 35 U.S.C. §102(e).

In view of the above discussion, withdrawal of the rejection of Claims 1 -2 and 32 under 35 U.S.C. §102(e) over Watanabe is respectfully requested.

Applicants have not addressed any issues relating to the PCT publication date of the Watanabe reference since a rejection under 35 U.S.C. §102(a) over the PCT application WO98/03047 was not made by the Examiner in the present Office Action.

**Conclusion**

In view of the foregoing amendments and remarks, favorable reconsideration is respectfully requested.

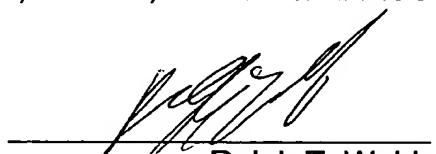
Should the Examiner believe that anything further is necessary to place this application in condition for allowance, the Examiner is requested to contact

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applicants' undersigned attorney at the telephone number listed below.

Kindly charge any additional fees due, or credit overpayment of fees, to  
Deposit Account No. 01-2135 (566.39636X00).

Respectfully submitted,  
ANTONELLI, TERRY, STOUT & KRAUS



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